

5/18/01

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Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Matsushita Electric Corporation of America

Serial No. 75/419,366

Morton Amster of Amster, Rothstein & Ebenstein for
Matsushita Electric Corporation of America.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Daniel Vavonese, Acting Managing Attorney).

Before Simms, Cissel and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Matsushita Electric Corporation of America seeks to
register PALMTHEATER as a mark for goods identified as
"portable digital video disc players."¹ Registration has
been refused under Section 2(e)(1) of the Trademark Act, 15
U.S.C. §1052(e)(1), on the basis that, as used on or in

¹ Serial No. 75/419,366, filed January 16, 1998, based upon an
allegation of a bona fide intention to use such term in commerce.
The application was subsequently amended to assert April 30, 1998
as the date of first use and first use in commerce.

connection with applicant's goods, the mark is merely descriptive of them.

When the Examining Attorney made the refusal final, applicant appealed. Briefs were filed, but an oral hearing was not requested. We affirm the refusal of registration.

As a preliminary matter, we note that the application includes a disclaimer for the term "theater." Applicant, however, entered that disclaimer when applicant's mark was set forth as PALM THEATER (two words rather than one) and a previous Examining Attorney had determined that that mark would be registrable with such a disclaimer. After applicant's amendment to allege use was filed, the same Examining Attorney determined that the mark should properly be set forth as one word (and should be refused registration). Applicant filed an amended drawing of the mark with its brief, setting forth the mark as one word. The current Examining Attorney has indicated in his brief both that the amended drawing is acceptable and that the disclaimer now is not necessary, in view of the unitary nature of the amended mark. Accordingly, the Board has corrected Office records to delete the disclaimer.

The Office bears the burden of setting forth a prima facie case in support of a descriptiveness refusal. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

To meet the Office's burden, the Examining Attorney has made of record excerpts of articles retrieved from the NEXIS database of publications, some of which show use of "palm-size(d) DVD," and one of which shows use of "Portable DVD Theater"²; various definitions of the term "palm" from the online edition of The American Heritage Dictionary of the English Language; reprints of information from the Office's search system regarding registered marks that include either "palm" or "theater"; and information retrieved from the applicant's web site.

All the timely introduced evidence from the Examining Attorney has been considered. We have not, however, considered a definition of "palm" from an on-line "technology glossary" offered by the Examining Attorney as an attachment to his brief. Likewise, we have not considered the NEXIS evidence offered by applicant in conjunction with its reply brief. See Trademark Rule 2.142(d) in regard to both of these proffers. See also, in regard to the Examining Attorney's proffer and request that we take judicial notice of the on-line glossary definition, In re Total Quality Group Inc., 51 USPQ2d 1474, 1475-76

² In regard to the NEXIS evidence purportedly relating to the term "theater," we note that all but the one reference cited above refer to the Samsung "P-Theater portable DVD" player, and do not use the word "theater" standing alone.

(TTAB 1999) (The Board will not take judicial notice of Internet dictionary evidence not made of record by Examining Attorney prior to briefing).

The Examining Attorney argues that both "palm" and "theater" are descriptive of a portable DVD player, and that the combination of the two terms into PALMTHEATER does not create a composite that is incongruous or registrable under any similar theory. In regard to the PALM portion of the composite, the Examining Attorney argues that "palm" is descriptive because applicant's DVD player is essentially palm-sized; that one definition of "palm" is a "unit of length equal to either the width or the length of the hand"; that pictorial representations of applicant's goods on its specimens and web site show that the DVD player fits on an outstretched hand; that "palm" has become descriptive of "portable devices ... small enough to be held in one's hand"; and that applicant, on its web site, touts its goods as "'DVD perfection'--in the palm of your hand." In regard to the THEATER portion of the composite, the Examining Attorney argues that applicant uses "theater" in a descriptive or generic fashion in references to its goods; that applicant readily entered a disclaimer of the term "theater" when it was requested by a prior Examining Attorney, and made no argument that the term is not

descriptive; and that the non-party registrations, for marks including the term "theater" for various items of audiovisual equipment, evidence the descriptiveness of that term for such goods because these marks are either on the Supplemental Register or include disclaimers of "theater."

Applicant argues that PALM is not descriptive of its portable DVD player because it cannot fit in the true palm of one's hand; that "the commonly understood meaning of the word 'palm'," in the context of references to size, is something that is small enough to fit in a person's palm, not something sized to fit in a person's hand; that use of "palm-size(d)" may refer to something the size of one's hand, but the use of palm alone does not; that even if palm has become descriptive for certain portable devices, it has not become descriptive for DVD players; that "palm" is only suggestive of the "portable nature and reduced size" of applicant's goods; that applicant's ownership of prior registrations for marks including the term "palm" evidence the suggestiveness of the term; that "theater," defined as a site for presentation of dramatic performances or movies is incongruous as used in conjunction with applicant's goods; and that its mark must be considered as a composite which combines "incompatible" terms, is "disconcerting" to those confronted with the mark, and requires some measure

of imagination or pause for the meaning of the composite to be grasped.

It is, of course, well settled that the question whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with those goods and the possible significance that the term would have to the average purchaser or user of the goods. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830 (TTAB 1977). A proposed mark is considered merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, *supra*.

By its argument, applicant essentially has conceded that characterizing an object as "palm-size(d)," as in the NEXIS references to "palm-size(d) DVD" players, is equivalent to characterizing the object as capable of being held in one's hand. Yet applicant contends that one would not use the term "palm" alone as a descriptor for the same

object unless the object could truly fit in only the palm of the hand, i.e., that portion of the hand from the end of the wrist to the base of the fingers.

We find the distinction strained. We rely, in this regard, on the Examining Attorney's definition of "palm" as including the measure of the length or width of one's hand and on the following two definitions, of which we take judicial notice³:

palmtop A computer small enough to hold in one hand and operate with the other. Palmtops may have specialized keyboards or keypads for data entry applications or have small qwerty keyboards. The Computer Glossary 287 (9th ed. 2001).

palmtop computer (*palm-tahp com-pyoo-ter*) A teensy-tiny computer that fits in the palm of your hand. Or, following the laptop metaphor, a computer that would fit into the palm of your hand if you had abnormally huge hands. Palmtop computers generally have all the hardware of their desktop cousins, but a tinier keyboard and monochrome display. ... Illustrated Computer Dictionary for Dummies 219 (4th ed. 2000).

Each of these two definitions evidences colloquial use of "palm" to refer to electronic devices (in these references, computers) which can be held in one's hand. We find it unlikely that, as applicant contends, "palm" and

³ The Board may take judicial notice of dictionary definitions. B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).

"palm-size(d)" would be carefully used by manufacturers or consumers of handheld electronic devices to distinguish between different measures of such objects. We find it a much more reasonable conclusion that "palm" and "palm-size(d)" would be used interchangeably to refer to the size of a portable electronic device as roughly that which would fit in or on one's hand.

We also find persuasive the Examining Attorney's argument that the PALM portion of PALMTHEATER, given the photographs applicant employs in its advertising (which show its DVD player resting on an open hand) and given applicant's promotion of its goods as "'DVD perfection'-in the palm of your hand," would be taken as a direct reference to the handheld size of the goods. We find unpersuasive applicant's argument that the phrase "'DVD perfection'-in the palm of your hand" would be taken as a figurative reference to users of applicant's goods having mastery or control over the best DVD technology available. Applicant's intent in adopting and using the phrase is not determinative. Even if the promotional phrase were viewed by some as embodying this message, we find that a majority would be likely to view the phrase as a reference to the size of the goods, especially in view of the images

applicant employs, and its characterization of its goods as "ultra-compact."

In regard to the THEATER portion of applicant's mark, we also find this term descriptive, as evidenced by applicant's own characterization of the goods as "the world's first portable DVD theater," by the registrations made of record by the Examining Attorney⁴, and by applicant's statement on its web site that a survey of its customers "indicated that a majority of PalmTheater owners connect their portable players to a TV or home theater system when not being used during travel." It is clear that "theater" and "home theater" have a descriptive connotation when used in conjunction with audio and video devices marketed to consumers. We find nothing in the

⁴ Registrations can be considered to indicate the meaning of portions of marks in the same way as dictionary definitions or other evidence of common usage. See The Conde Nast Publications Inc. v. Miss Quality, Inc., 180 USPQ 149, 152 n.3 (TTAB 1973), *aff'd* 184 USPQ 423 (CCPA 1975).

Registrations of record on the Supplemental Register include: HOME THEATER MASTER for a remote control device for home audio and video equipment; for THEATER SURROUND for televisions and their audio circuits; and for VIRTUAL THEATER for "speakers, amplifiers, subwoofers, motion actuators, motion controllers."

Registrations of record on the Principal Register with a disclaimer of "home theater" include HOME THEATER MADE EASY for loudspeaker systems; AUDIOFILE HOME THEATER for a variety of audio products, including speakers; and HOME THEATER SYNERGY for "consumer electronic equipment; namely, audio and video speakers, amplifiers, players, and displays." Finally, there is a Principal Register registration for SUPERCO HOME THEATER & APPLIANCES and design, with a disclaimer of "home theater & appliances," for televisions, radios, and stereo equipment, among other items.

nature of applicant's goods that would lead consumers to view the term "theater" in any other way.

While we are mindful that we must consider PALMTHEATER in its entirety, this does not preclude our foregoing consideration of the component parts to determine their usual meaning in conjunction with applicant's goods. Having determined that the two component parts are merely descriptive, we must consider whether, as applicant contends, the combination of the terms creates a registrable composite.

We find that the combination is no less descriptive than the individual components. In this regard, we note that we consider the composite in conjunction with the identified goods, not in the abstract. When so considered, consumers will not likely think of the "incompatible" ideas of a movie theater or place for dramatic performances and the anatomically precise palm of one's hand. Rather, consumers will readily perceive, without need of thought or imagination, that applicant's DVD players are "home theater" type components that have been miniaturized to handheld or "palm" size.

The fact that applicant may be the first and/or only entity using the phrase PALMTHEATER is not dispositive where, as here, the term unequivocally projects a merely

descriptive connotation. See In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973). Moreover, it is not necessary that the term be in common usage in the particular industry before it can be found merely descriptive. See In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Finally, we note applicant's argument that it has obtained other registrations for PALMCAM, PALMCORDER IQ, and PALMCORDER, and that PALMTHEATER is another in a "family of suggestive PALM-formative Marks and is therefore entitled to registration." It is well settled that each case must be taken on its own merits and that the Examining Attorney's refusal to register PALMTHEATER is not an impermissible collateral attack on applicant's prior registrations. See In re Sunmarks Inc., 32 USPQ2d 1470 (TTAB 1994). In addition, the records developed in those cases may have been different than in the case at hand. Finally, we note that those registrations are based on applications that were filed years ago and during the interim there has been a proliferation of portable and handheld electronic devices of various types, so that analysis of an application to register a "PALM-formative" mark today is different from the analysis of just a few years ago. Cf. In re Styleclick.com Inc., 57 USPQ2d 1445,

1448 (TTAB 2000) (discussing rapid advancement of the Internet in time that had passed since certain "e-" prefixed marks had been registered). In short, we do not find applicant's prior registrations persuasive support for applicant's argument that we must view PALMTHEATER as one member of a family of suggestive marks.

Decision: The refusal of registration under Section 2(e)(1) of the Trademark Act is affirmed.